

## REMARKS

This paper is filed in response to the Office Action dated July 1, 2004. As this paper is filed on December 1, 2004 with a petition for a two-month extension, the paper is timely filed.

### I. Status of Amendments

Claims 1-115 were pending prior to this response. In accordance with applicants' response dated April 2, 2004, claims 4-9, 13-15, 22-26, 40-46, 50-53, 56, 75-80, 84-86, 97-103 and 107-110 stand withdrawn. Additionally, claims 1, 3, 11, 19, 30, 38-40, 55, 63, 64, 66, 68-70, 72 and 87-90 have been amended, and claims 25, 37, 46, 53, 103 and 110 have been cancelled. Thus, claims 1-24, 26-36, 38-45, 47-52, 54-102, 104-109, and 111-115 remain pending, with claims 4-9, 13-15, 22-24, 26, 40-45, 50-52, 56, 75-80, 84-86, 97-102 and 107-109 withdrawn.

### II. Response to the Office Action

#### A. General Comments

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

"invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence "As used herein, the term '\_\_\_\_\_ ' is hereby defined to mean..." or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word "means" and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the "broadest reasonable interpretation" of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. *In re Wright*, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) ("[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement."). The

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INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

**B. The July 1 Office Action**

Claims 1, 3, 11, 37, 38, 40, 55, 63, 64, 66, 68, 69, 70, 72, 87, 88, and 89 were objected to as containing certain informalities. Applicants have amended claims 1, 3, 11, 38, 55, 63, 64, 66, 68, 69, 70, 72, 87, 88, and 89 (as well as withdrawn claim 40) in response. Applicants also amended claim 39 to remove language which raised an objection as to, for example, claim 3. The rejection in regard to claim 37 is moot, as claim 37 has been cancelled.

Claims 1-3, 16-18, 71-74, and 87-89 are rejected under 35 U.S.C. 103 as allegedly unpatentable over Nicastro, Sr. (US Published Application No. 2003/0027619). Also, claims 10-12, 19-21, 27-35, 54, 55, 57-70, 81-83, 90-96, 104-106, and 111-115 are rejected under 35 U.S.C. 103 as allegedly unpatentable over Nicastro, Sr. in view of Kelly et al. (US Patent No. 6,007,426).

Initially, applicants note that they have amended claims 19, 30, and 90. Specifically, claim 19 now recites, in pertinent part, that “said bonus game [comprises] an interactive computer generated Virtual Reality game of skill awarding a bonus in relation to a level of a corresponding physical interaction of a player.” Similarly, claim 30 recites “for participating in said shared Virtual Reality bonus event of skill awarding a bonus in relation to a level of a corresponding physical interaction of a player located thereat.” Likewise, claim 90 recites “participating in a shared Virtual Reality bonus event of skill for receiving a bonus event award in relation to a level of a corresponding physical interaction of a player when qualified to participate in said shared Virtual Reality bonus event.”

Consequently, applicants traverse the rejections on the basis that Nicastro, Sr. is not applicable against the present application, and thus the rejections presented in reliance on Nicastro, Sr. and on Nicastro, Sr. in combination with Kelly et al. must be withdrawn. According to the published application, Nicastro, Sr. has a filing date of July 25, 2002, which is after applicants’ filing date of December 20, 2001. Thus, the application that was

published would not be available under 35 U.S.C. 102 against applicants' application. Further, while Nicastro, Sr. claims the benefit of an earlier filed provisional application, Serial No. 60/307,757, filed on July 25, 2001, the undersigned has examined the provisional application and notes (i) that paragraphs [0071] and [0072] were not present in the provisional application and (ii) that portion of paragraph [0053] believed to have been relied upon by the examiner<sup>2</sup> was not present in the provisional application. Consequently, the earliest date that these paragraphs or portions or paragraphs are entitled to is the July 25, 2002 filing date, which, as stated above, is after applicants' filing date.

**C. Supplemental Information Disclosure Statement**

Applicants submit herewith a Supplemental Information Disclosure Statement, with the fee under 37 C.F.R. 1.17(p).

In view of the foregoing, it is respectfully submitted that the rejections have been traversed, and reconsideration is respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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<sup>2</sup> In particular, as to paragraph [0053], applicants believe that the examiner was relying upon the statement that "[t]he player skills can be decision making skills or physical skills," and upon the statements made in last 11 lines of the paragraph.